APPENDIX

[Filed July 15, 1998]

UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

Appeal Nos. 95-1514, -1515

GILBERT P. HYATT,
Appellant,

-v.-

GARY W. BOONE,
Cross-Appellant.

Appeal from a Decision of the
Board of Patent Appeals and Interferences
dated September 19, 1995 and May 10, 1996

GILBERT P. HYATT'S PETITION FOR
REHEARING AND SUGGESTION FOR
REHEARING IN BANC

* * * *

INTRODUCTION

This is an appeal from a decision of the United States Patent and Trademark Office, Board of Patent Appeals and Interferences (the "Board"). The appeal involves a patent interference between (1) U.S. Patent No. 4,942,516, entitled "Single Chip Integrated Circuit Com-

puter Architecture," issued to Gilbert P. Hyatt ("Hyatt") and claiming priority to original patent application Serial No. 101,881 (the "'881 application") and (2) patent application Serial No. 473,541, entitled "Variable Function Programmed Systems" by Gary W. Boone ("Boone"). The primary issue on appeal is whether the '881 application provides a written description of a computer having two memories and a processing circuit implemented on a single integrated circuit chip as defined by the sole Count-in-interference (the "Count").

POINTS OF FACT AND LAW OVERLOOKED OR MISAPPREHENDED BY THE PANEL

As detailed in Hyatt's opening and reply briefs, it is *undisputed* that the body of the '881 application expressly describes an electronic data processing system—a computer—having two memories and a processing circuit that operate as required by the Court. It is also *undisputed* that the body of the application describes the data processing system implemented as a completely integrated circuit or "monolithic" computer, and that a monolithic computer is a computer implemented on one or more chips. It is thus *undisputed* that the body of the '881 application expressly describes all the limitations of the Count except for the specific words "single integrated circuit chip." However, it is also *undisputed* that original Claim 40 of the '881 application expressly describes an "electronic data processing system . . . implemented on a single integrated circuit chip." Since an original claim is to be read on what is disclosed in the application and not as a different embodiment, *Bocciarelli v. Huffman*, 232 F.2d 647, 651, 109 USPQ 385, 388 (C.C.P.A. 1956), the description of a monolithic computer in the body of the application must be read together with original Claim 40. Together they provide a complete, express description of the Count.

Simply put, the body of the '881 application expressly describes the computer defined by the Count and original

Claim 40 complements that description by expressly describing implementation of *the disclosed computer* on a single integrated circuit chip. As a result, the '881 application provides a complete written description of the Count—it "reasonably conveys" to those skilled in the art that Hyatt was in possession of the invention defined by the Count.

In deciding this appeal, the Panel ignored the body of the '881 application on the mistaken belief that it did not describe or suggest a single chip computer. It then decided that original Claim 40 *alone* did not "necessarily" provide a written description of the Count. The Panel failed to consider claim 40 in conjunction with the monolithic computer—a computer implemented on one or more chips—even though it is undisputed that claim 40 reads on the previously described monolithic computer and expressly describes implementation on a single chip. The Panel looked only at original Claim 40, despite the requirement to consider the application "as a whole." *See, e.g., In re Wright*, 866 F.2d 422, 425, 9 USPQ 2d 1649, 1651 (Fed. Cir. 1989) (application must be considered "as a whole" to decide compliance with 35 U.S.C. § 112, ¶ 1).

Accordingly, Hyatt submits this petition for rehearing because the Panel overlooked or misapprehended the express teaching in the body of the '881 application of a completely integrated circuit or monolithic computer.

ISSUE OF LAW NECESSITATING CONSIDERATION OF THE FULL COURT TO MAINTAIN UNIFORMITY OF ITS DECISIONS

Prior precedent of this Court has held that the proper test for determining compliance with the written description requirement of 35 U.S.C. § 112 ¶ 1 when dealing with an express diclosure is whether an application "reasonably conveys" possession of the invention. *See, e.g., Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1562-63, 19 USPQ2d 1111, 1115-16 (Fed. Cir. 1991). Prior prece-

dent has also developed a stricter "necessary and only" test for meeting the written description requirement when an inventor needs to rely on an *inherent* feature not expressly described within his application. *See, e.g., Kennecott Corp. v. Kyocera Int'l Inc.*, 835 F.2d 1419, 1423, 5 USPQ2d 1194, 1198 (Fed. Cir. 1987), *cert. denied*, 486 U.S. 1008 (1988) (hereinafter "*Kennecott*"). *See also In re Daniels*, No. 97-1225, 1998 WL 257309 at *2, 46 USPQ2d 1788 (Fed. Cir. May 20, 1998) (necessary test used when a disclosure is "less than clear on its face . . .")

The Panel in the present case recognized that this Court's precedent has used the two phrases "reasonably conveys" and "necessary and only" in deciding written description issues. (Decision, p. 9.) However, the Panel held that those two distinct phrases were not "divergent standards for compliance with § 112." (Decision, p. 9-10.) As a result, the Panel established a new precedent—it merged the standard for express disclosure into the standard for inherent disclosure and phrased the merged standard as a "necessarily comprehended" test for written description. (Decision, p. 10.) The Panel then applied its "necessarily comprehended" test to decide that the '881 application did not provide a written description of the Count. (Decision, p. 10.)

The Panel's "necessarily comprehended" test applied to an express written description is in direct conflict with prior precedent of this Court. Moreover, by applying its overly-strict "necessarily comprehended" test, the Panel reached the wrong result—finding that the '881 application did not provide a written description of the Count. Accordingly, Hyatt suggests that the present appeal be reheard in banc to allow this Court to maintain uniformity with its prior decisions concerning the written description requirement of 35 U.S.C. § 112, ¶ 1.

ARGUMENT

A. The Panel Overlooked or Misapprehended the Fact That the Body of the '881 Application Describes A Completely Integrated Circuit or Monolithic Computer

When a panel overlooks or misapprehends an essential fact or rule of law, rehearing of the appeal is appropriate, Fed. Cir. R. 40; *See, e.g., Frederick v. Department of Justice*, No. 95-3194, 1996 WL 293120, *1 (Fed. Cir. May 22, 1996). That has happened here.

Central to the Panel's decision that the '881 application did not provide a written description of the Count was its erroneous findings (i) that other than original Claim 40, there is no description or suggestion in the body of the application of a computer implemented on a single integrated circuit chip and (ii) that the Board made a similar finding. As stated by the Panel:

> *There is no other mention in the '881 application of a single integrated circuit chip*, although other electronic data processing systems are extensively described.
>
> * * *
>
> *The Board found* that the parts of the written description that are lacking from Claim 40 are not provided elsewere in the '881 specification, whose systems and circuitry neither describe nor suggest a computer on a single chip.

Decision, pp. 6-7 (Emphasis added).

The Panel then looked only at original Claim 40 without reference to the body of the application and decided that Claim 40 *alone* did not describe the two memories and the single chip processing circuit of the Count.

The Panel made a fundamental and material error. The body of the '881 application *does* describe a com-

pletely integrated circuit or monolithic computer. Moreover, the Board *never* made a contrary finding.

The body of the '881 application expressly describes in detail a computer having two memories and a processing circuit that operate as recited in the Count. As clearly shown in Figs. 1 and 4 (A326), it is undisputed that the application discloses an electronic data processing system having (1) a main memory 30 for storing computer instructions (the "main memory" of the Count), (ii) an alterable scratch pad memory 110 which stores operands (the "operand memory" of the Count), and (iii) a data processor 12 which processes operands stored in the alterable scratch pad memory 110 in response to instructions stored in the main memory 30 (the "processing circuit" of the Count). For a more detailed discussion of these features see Hyatt's Main Brief, pp. 10-17.

The application also teaches that the basic design or "architecture," of its processing circuit 12 permitted the system to use an integrated circuit read only memory to create a "completely integrated circuit computer," expressly described as a "monolithic computer." (A210, lines 13-19.) The term "monolithic computer" was understood in the art as an express description or suggestion of a computer capable of being implemented on a single integrated circuit chip. (A493-95, A431-32, A1011-12.) In fact, Boone's own expert witness, Dr. Wooley, testified that the term "monolithic" described a single integrated circuit chip, or a combination of integrated circuits, i.e. one or more chips. (A 3103.) Further, Boone himself used the term "monolithic calculator" to describe his single chip calculator in the corresponding Boone application-in-interference. (*See, e.g.*, A2534, line 12.) See Hyatt's Reply Brief, pp. 6-7, for further discussion of the term monolithic.

The Panel's error in not considering the application's disclosure "as a whole", including the description of a

monolithic computer and not reading Claim 40 in conjunction with that disclosure was not harmless. *In re Wright*, 866 F.2d 422, 425, 9 USPQ2d 1649, 1651 (Fed. Cir. 1989).

It is black letter law that an original claim to an application is part of the original disclosure. *Northern Telecom, Inc. v. Datapoint Corp.*, 908 F.2d 931, 938, 15 USPQ2d 1321, 1326 (Fed. Cir.), *cert. denied*, 498 U.S. 920 (1990); *In re Edwards*, 568 F.2d 1349, 1352, 196 USPQ 465, 468 (C.C.P.A. 1978). However, to determine what an original claim decribes for § 112 purposes, one must look at what the original claim discloses in the context of the body of the application rather than as a different embodiment. *Bocciarelli v. Huffman*, 232 F.2d 647, 651, 109 USPQ 385, 388 (C.C.P.A. 1956). Accordingly,

> if an original claim can be given a reasonable interpretation which will make it readable on what is disclosed in the specification or drawing, it is proper to adopt that interpretation rather than to seek to construe broad language in the claim as a disclosure of other embodiments.

Id. at 651, 109 USPQ at 388.

The rationale for that rule is clear. Original claims to an application are designed to broadly point out the novel features *of the invention disclosed in the original application*. In this case, Claim 40 is fully compatible with the monolithic computer disclosed in the body of the '881 application. The read only memory means of Claim 40 corresponds to the integrated circuit read only memory 30 of the monolithic computer while the alterable memory means of Claim 40 corresponds to the alterable operand memory 110 of the monolithic computer. Regardless of whether the program means of Claim 40 is interpreted to mean a program or a data processing circuit, it is consistent with the previous description of a monolithic com-

puter, which has both. Further, since Boone's own witness testified that monolithic is defined as implementation on one or more chips (A3103), the Claim 40 recitation of a single chip is also fully compatible with the monolithic computer.

It is thus clear that there are no differences that can support a conclusion that Hyatt's monolithic computer and Claim 40 represent different embodiments. *See also* Hyatt's Main Brief pp. 17-18 and Hyatt's Reply Brief pp. 5-13. Boone has not, and indeed cannot, point to a single element of Claim 40 that is incompatible with Hyatt's previously disclosed monolithic computer that is to be implemented on one or more chips. Since Claim 40 is fully consistent with the monolithic computer, the descriptions of the monolithic computer and of Claim 40 must be read together as the description of a single embodiment.

Contrary to the decision (p.6), Hyatt does *not* contend that Claim 40 by itself describes the subject matter of the inference count. Hyatt does contend, and it is *undisputed,* that the body or the application expressly describes a monolithic computer having every feature of the count implemented on one or more chips. When this undisputed description is combined with the single chip recitation of Claim 40, which reads on Hyatt's monolithic computer, the '881 application provides an express written description of every feature of the Count.

In re Ruschig, 379 F.2d 990, 154 USPQ 118 (C.C.P.A. 1967), is the first case clearly recognizing the written description requirement. 4 Chisum § 7.04[1][a][1] (1998). The court there stated:

> It is an old custom in the woods to mark trails by making blaze marks on the trees. It is no help in finding a trail or in finding one's way through the woods where the trails have disappeared—or have not yet been made. . .—to be confronted simply by

> a large number of unmarked trees. Appellants are pointing to trees. We are looking for blaze marks which single out particular trees.

In re Rushig, 379 F.2d at 994-95, 154 USPQ at 122. The detailed teaching of a completely integrated circuit or monolithic computer in the body of the '881 application, in combination with Claim 40, provides just such blaze marks to the subject matter of the Count.

B. This Appeal Should Be Heard In Banc To Maintain Uniformity With Prior Precedent On The Proper Test for the Written Description Requirement Under 35 U.S.C. § 112, ¶ 1

A rehearing in banc will be ordered when a Panel's decision is contrary to prior precedent and, as a result, consideration of the full Court is necessary to secure or maintain uniformity of its decisions or overrule its prior decisions. Fed. Cir. R. 35; *see also Cybor Corp. v. FAS Technologies, Inc.* 138 F.3d 1448, 1455-56, 46 USPQ2d 1169, 1173 (Fed. Cir. 1998) (in banc review required in order for this Court to maintain uniformity of its decisions concerning the proper standard of review for claim construction issues); *Nobelpharma AB v. Implant Innovations, Inc.,* 141 F.3d 1059, 1068 n.5, 46 USPQ2d 1097, 1104 n.5 (Fed. Cir. 1998) (in banc review required to overrule this Court's prior decisions concerning antitrust issues). Since the Panel's decison concerning the written description requirement is contrary to this Court's precedent, a rehearing in banc is warranted.

As detailed in Hyatt's opening and reply briefs, when an application expressly discloses the invention the proper test for determining compliance with the written description requirement of 35 U.S.C. § 112 is whether that disclosure "reasonably conveys" to one skilled in the art that the inventor was in possession of the later claimed invention. *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1562-63, 19 USPQ2d 1111, 1115-16 (Fed. Cir. 1991). The

"reasonably conveys" test has been consistently applied by this Court in deciding the issue of express written description under § 112.[1] Moreover, it has been adopted by the PTO as the proper test for review of patent applications.[2]

However, unlike the present case, when an application does not expressly describe a claim limitation but discloses a device that "inherently" has a property meeting that limitation, the inventor can rely on that inherent property to satisfy the written description requirement. *In re Reynolds*, 443 F.2d 384, 389, 170 USPQ 94, 98 (C.C.P.A. 1971). To prove the inherent property, the inventor has to meet a stricter "necessary and only" test—the inventor must show that the " 'necessary and only reasonable construction to be given the disclosure by one skilled in the art is one which will lend clear support to . . . [this] positive limitation.' " *Kennecott*, 835 F.2d at 1423, 5 USPQ2d at 1198 (quoting *Langer v. Kaufman*, 465 F.2d 915, 918, 175 USPQ 172, 174 (C.C.P.A. 1972)). The same "necessary and only" test for an inherent disclosure is also used when determining whether a prior art reference under 35 U.S.C. § 102 inherently discloses a claimed feature.[3]

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1 *See, e.g., Eiselstein v. Frank*, 52 F.3d 1035, 1039, 34 USPQ2d 1467, 1470 (Fed. Cir. 1995); *In re Hayes Microcomputer Prods., Inc.*, 982 F.2d 1527, 1533, 25 USPQ2d 1241, 1245 (Fed. Cir. 1992); *Ralston Purina Co. v. Far-Mar-Co., Inc.*, 772 F.2d 1570, 1575, 227 USPQ 177, 179 (Fed. Cir. 1985) (hereinafter "*Ralston Purina*").

2 Manual of Patent Examining Procedure § 2163 (1996); *Request for Comments on Interim Guidelines for Examination of Patent Applications Under the 35 U.S.C. 112 ¶ 1* (hereinafter "*Interim Guidelines*"); *"Written Description" Requirement*, 63 Fed. Reg. 32,639-45 (1998).

3 *See, e.g., Electro Medical Sys., S.A. v. Cooper Life Sciences, Inc.*, 34 F.3d 1048, 1052, 32 USPQ2d 1017, 1020 (Fed. Cir. 1994) (Court applied necessary test to determine if prior art inherently anticipated claimed invention); *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1268-69, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991) (same).

Very recently, this Court touched on this issue when it reiterated that the "reasonably conveys" test is used to determine compliance with the written description requirement, citing *Ralston Purina,* and the "necessary" test is used when a disclosure is "less than clear on its face," citing *Kennecott,* an inherency case. *In re Daniels,* No. 97-1225, 1998 WL 257309, at *2 (Fed. Cir. May 20, 1998).

In view of the distinct standards, this Court has held that when an application expressly describes a limitation, as in the present case, it is reversible error to apply the "necessary and only" test. Specifically, if the limitation is expressly described, it is improper to require the application to "necessarily exclude" other limitations or "necessarily include" a limitation that excludes all other possible limitations. *Vas-Cath,* 935 F.2d at 1566-67, 19 USPQ2d at 1119 (district court committed reversible error by requiring under § 112 that the original application *necessarily exclude* other limitations not claimed after expressly describing the claimed limitation).

The Panel in the present case recognized that prior precedent of this Court has used the two phrases "reasonably conveys" and "necessary and only" in deciding written description issues. (Decision, p. 9.) However, the Panel held that those two distinct phrases were not "divergent standards for compliance with § 112." (Decision, pp. 9-10.) As a result, the Panel established new precedent—it merged the standard for explicit disclosure into the standard for inherent disclosure using the phrase "necessarily comprehended." (Decision, p. 10.) The Panel then applied its strict "necessarily comprehended" test to an explict disclosure to decide that original Claim 40, standing alone and apart from its supporting disclosure, did not provide a written description of the Count. (Decision, p. 10.)

The Panel's decision is in direct conflict with the prior precedent of this Court which established the "reasonably

conveys" test as the proper test for express written description. The Panel's decision is also in conflict with the recently published *In re Daniels* decision which recognized that a distinction in the law exists.

If left standing, the Panel's decision will wrongfully deny Hyatt priority to his original application. As detailed above, there is no dispute that (1) the '881 application describes a monolithic computer having two memories and a processing circuit that operated as recited in the Count and (2) original Claim 40 describes implementing a computer on a single integrated circuit chip. Since the three elements recited in Claim 40 are all found in the monolithic computer, one skilled in the art would recognize that the computer described in original Claim 40 is the same monolithic computer that is described throughout the body of the application. To require that original Claim 40 necessarily exclude all other computers is an improper standard for complying with the written description requirement. *Vas-Cath Inc.*, 935 F.2d at 1566-67, 19 USPQ2d at 1119.

Moreover, the Panel's decision will wreak havoc in the PTO—where numerous applications are reviewed daily for compliance with the written description requirement—and in the courts whenever the written description requirement is at issue.

As applied, the Panel's "necessarily comprehended" test would require inventors to not only describe their inventions but also to expressly describe what their inventions necessarily *exclude*. That is, to expressly describe all embodiments which the inventor does *not* consider to be his invention, as was the effect of the decision in this case.

The Panel's decision also adds to the confusion in this Circuit concerning the written description requirement rather than clarifying it. For example, as discussed above, in *In re Daniels* this Court defined a second "necessary"

test that is to be applied when a disclosure is "less than clear on its face" and then cited an inherency case, *Kennecott*, as authority. In another example, *Gentry Gallery, Inc. v. Berkline Corp.*, 134 F.3d 1473, 1480, 45 USPQ2d 1498, 1503-04 (Fed. Cir. 1998), this Court decided that a disclosure of a preferred embodiment was insufficient under the written description requirement to support a claim broader than that which was expressly disclosed—a decision sharply criticized by the patent bar. *See, e.g.*, Laurence H. Pretty, *Federal Circuit Narrows the Protection of Patents Closer Toward Their Specific Disclosures*, IPL Newsletter, Vol. 16, No. 3, Spring 1998.

Finally, the PTO recently published *Interim Guidelines* setting forth its understanding of the law concerning the written description requirement under 35 USC §112, ¶ 1 and requesting comments.

In view of the Panel's improper, and case dispositive, restatement of the test for written description, recent decisions of this Court obfuscating the law on written description, and the PTO's recent request for comment, Hyatt suggests that this appeal be heard in banc to allow this Court the opportunity to maintain uniformity with its prior decisions and to clarify the law concerning the written description requirement under 35 U.S.C. § 112, ¶ 1.

CONCLUSION

For the reasons stated above, the Panel should rehear this case. If the Panel decides not to rehear this case, the Court should set this case for in banc briefing and argument.

Respectfully submitted,

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BRIEF FOR APPELLANT GILBERT P. HYATT

STATEMENT OF THE ISSUES

POINT I:

Whether the Board committed reversible error in denying Hyatt benefit of the '881 application by deciding that the application failed under 35 U.S.C. § 112 to describe a "computer on a chip" as defined by the Count.

A. Whether the Board committed reversible error by looking *only* at original Claim

40, failing to consider the *whole* '881 application.

B. Whether the Board committed reversible error by improperly applying the "necessary" test for an inherent description instead of the proper "reasonably conveys" test for an express description.

POINT II:

Whether the Board committed reversible error in giving Boone benefit of his 1971 application in view of at least two breaks in his chain of priority applications.